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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,331	09/27/2006	Hugues Da Dalt	296328US6PCT	3308

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.		
1940 DUKE STREET		
ALEXANDRIA, VA 22314		

EXAMINER	
LUONG, VINH	

ART UNIT	PAPER NUMBER
3656	

NOTIFICATION DATE	DELIVERY MODE
05/11/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/594,331	Applicant(s) DA DALT ET AL.	
	Examiner Vinh T. Luong	Art Unit 3656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/30/10; 9/27/06 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Appendix</u> . |

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1. The amendment filed on March 30, 2010 has been entered.
2. Applicant's election without traverse of the species of FIGS. 1-6 in the reply filed on March 30, 2010 is acknowledged.
3. Claims 6-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 30, 2010.
4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The abstract of the disclosure is objected to because of the implied phrase "The invention concerns . . ." Correction is required. See MPEP § 608.01(b).
6. The drawings were received on March 30, 2010. These drawings are not accepted by the Examiner because the amendments to the drawings are not in compliance with 37 CFR 1.84 as required by 37 CFR 1.121(d). Please see Form PTO-948 attached.
7. The drawings are objected to because of the reasons, *inter alia*, listed below:
 - (a) The drawings are not in compliance with 37 CFR 1.84. See Form PTO-948 attached to this Office action and the restriction requirement on March 2, 2010; and
 - (b) Each part of the invention, such as, the bearing face in claim 3 should be designated by a reference character. See MPEP 608.01(o) and (g).

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Please note that MPEP 608.02(b) states: “To be fully responsive, an amendment must include corrected drawings. See 37 CFR 1.85(c) and 37 CFR 1.121(d). The objection to the drawings will not be held in abeyance” and “A request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action (37 CFR 1.135(c)).” For examples of proper drawings, see the “Guide for the Preparation of Patent Drawings” available from the USPTO web site at www.uspto.gov.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

8. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant’s use.

Arrangement of the Specification

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As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

9. The disclosure is objected to because of the informalities, such as, listed below:

- (a) The specification should have appropriate headings listed above; and
- (b) Each part of the invention, such as, the bearing face in claim 3 should be designated by a reference character. See MPEP 608.01(o) and (g).

Appropriate correction is required.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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11. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. For example, the phrase “a body (10) on which can be mounted in a fluid-tight manner a rotary maneuvering member (20)” in lines 3 and 4 of claim 1 is grammatically incorrect.

The terms, such as, “can be mounted,” “switchable,” and “movable” in claim 1 are vague and indefinite in the sense that things which may be done are not required to be done. For example, the body can be, but is not required structurally to be mounted in a fluid-tight manner. Compare “crimpable” in *In re Collier*, 158 USPQ 266 (CCPA 1968); “discardable” in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986); “removable” in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992); and “comparable” in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (BPAI 1992).

No antecedent basis is seen for the term, such as, “the rotary equipment” in claim 2.

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-4, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Duncan (US 3,247,349 cited in International Search Report).

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Claim 1

Duncan teaches a rotary knob for an electrical system comprising:

a body 6 on which *can be* mounted in a fluid-tight manner to a rotary maneuvering member 8 and to house a driving part 27, the maneuvering member 8 having a shank (at one end of the member 8. *Ibid.* 3:5-8. See Appendix hereinafter “App.”) for moving the driving part 27, the body 6 also serving as a support for at least one electrical block 12 (FIGS. 14 and 15) switchable in response to the rotation of the maneuvering member 8 via at least one axially moving slider 14 (FIGS. 4 and 5), the maneuvering member 8 being mounted in a rotary manner about an axis (*i.e.*, the longitudinal axis of the shaft 8 in FIGS. 3-5) with a limited angular movement, in order to assume at least two functional positions, maintained or transitory, and being locked in rotation with the driving part 27 which is provided with cam surfaces 32-34 for moving the sliders 14, characterized in that:

the body 6 of the knob has a recessed part 15a (FIG. 3) provided with an external cylindrical flange (App.), an internal cylindrical sleeve 16 and a cup (App.) defined between the flange (App.) and the sleeve 16 in order to house a torsion spring 19 acting on the maneuvering member 8, the cylindrical sleeve 16 defines a central opening (App.) with which a centering seat (App.) of the shank (App.) of the maneuvering member 8 cooperates.

Claim 1 is anticipated by Duncan since Duncan teaches one alternative in the alternative expression “a helical spring (R) acting on a sensitivity ring (30) separate from the driving part and movable in translation *or, respectively*, a torsion spring (R’) acting on the maneuvering member (20).” (Emphasis added). It is well settled that when the claim recites alternatives, that

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claim is anticipated by using the prior art that teaches one alternative. *Brown v. Air Products and Chemicals Inc.*, 60 USPQ2d 501(CAFC 2001).

Claim 2

The shank (App.) of the maneuvering member 8 and the driving part 27, each have a cylindrical seat (App.) ensuring the centering, in the central opening (App.) of the sleeve 16, of the rotary equipment consisting of the maneuvering member 8 and the driving part 27.

Claim 3

The driving part 27 is mounted by means of interlocking shapes (at 28 in FIGS. 3-5) on the shank (App.) of the maneuvering member 8 and has a shoulder 29 (FIG. 5) connected to its seat for being applied axially (via a projection 20 of the spring 19) against a bearing face (at 20 in FIG. 4) of the body 6. *Ibid.* 3:1-10.

Claim 4

The compression or torsion spring 19 housed in the cup (App.) has a height *substantially* of the same order as the height of the cylindrical sleeve 16 (FIGS. 4 and 5).

14. Claim 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

15. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Ansorge et al. (cam notches 19 and 20), Kellog (cam 13), and Klob (FIG. 1).

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday, Tuesday, Thursday, and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Luong/
Primary Examiner, Art Unit 3656